REMARKS

Claims 1-6 and 8-20 are pending in this application. Claims 1 and 17 have been amended. Claim 7 has been cancelled. Claims 1, 12 and 17 are independent claims.

In an Office action dated April 17, 2006, claims 1-11 were rejected under 35 U.S.C. 103(a) as allegedly being obvious over Abdelhadi et al. in view of Shrader et al. Claims 12-20 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Abdelhadi et al. in view of Shrader et al. and further in view of Duke et al.

In response to the rejection, claim 1 has been amended to more clearly distinguish the claimed invention from the cited prior art. Firstly, the claim has been amended to incorporate the features of original claim 7. Therefore, the claimed method of tracking hits includes sending a network file in response to a request from a requesting device, wherein the network file includes an instruction to transmit an indicator subsequent to the requesting device receiving the network file and wherein the instruction is embedded within the network file such that the instruction is transparent to an end-user at the requesting device. Claim 1 has also been amended to more definitively describe the step of transmitting the indicator as being one in which the transmission is from the requesting device as an automated response to receiving the network file. Support for the amendment may be found in various portions of the application as originally filed. For example, in paragraph [0009] it is stated that the instruction is embedded within an Internet file and may be compatible with JavaScript that is transparent to the end-user, while paragraph [0011] specifically states that the instruction triggers transmission.

Claim 17 has been amended merely to correct an error.

It is respectfully asserted that the amendments to claims 1 and 17 place all of the pending claims in a condition for allowance. Reconsideration is requested.

A. Claimed Invention

As described in the Background Art section of the application as originally filed, while caching regularly requested Web pages or other files increases the speed of the Internet, the use of proxy servers inhibits the ability to accurately count the number of "hits" for the requested file, since at least some of the requests will be intercepted and serviced by the proxy server. The method described in independent claim 1 addresses this concern by including an instruction with the requested network file, with the instruction being to transmit an indicator subsequent to the reception of the network file by the requesting device. The instruction is embedded within the network file such that the instruction is transparent to the end-user at the requesting device. The indicator is transmitted from the requesting device as an automated response to receiving the network file.

In independent claim 12, the method of counting the number of accesses includes embedding executable code in each of a plurality of cacheable documents, with the executable code including an instruction triggering transmissions of count-inducing messages from client devices. Then, the cacheable documents are sent to the client devices in response to requests. Count-inducing messages are transmitted from the client devices as responses to execution of the executable code upon reception of the cacheable documents. The accesses are counted on the basis of receiving the count-inducing messages.

The "tracking hits" system of independent claim 17 includes a store of network files, each having a command to initiate a transmission of an identifier from client devices upon reception of one of the network files by a client device. Programming that is accessible via each client device is configured to request the network files and to transmit the identifier upon reception of one of the network files at the client device. The system also includes a file access counter responsive to receiving the identifiers from the client devices as a basis for counting transfers of the network files to the client devices. The file access counter is configured such that counting updates a tally of the transfers of the network files to the client devices.

B. Patentability of Amended Claims 1-7 and 9-11

Claims 1-11 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Abdelhadi et al. in view of Shrader et al. Applicants respectfully assert that the combination of references as proposed in the Office action does not teach or suggest the invention described in claim 1, as amended. In the Office action, the "instruction to transmit an indicator" is identified as being the hyperlink embedded within a Web document as described in Abdelhadi et al. Applicants point out that the hyperlinks of the prior art are not embedded within a network file such that the hyperlink "is transparent to an end-user." Moreover, the hyperlink of the prior art is not transmitted from the requesting device as an automated response to receiving the network file. Also significant to the Section 103(a) determination is that it is inaccurate to state that paragraph [0005] of Abdelhadi et al. indicates that Abdelhadi et al. teaches a method of tracking hits for a network file.

Abdelhadi et al. teaches a system and method for previewing portions of hypertext WWW documents linked to hyperlinks in received WWW documents. As commonly known to persons who use the Internet, many Web pages include hyperlinks. Paragraph [0005] of Abdelhadi et al. states that a concern is that once a user accesses a particular Web document or page, there is no guidance as to which hyperlinks on the received Web page are linked to Web documents of greater or lesser significance. Therefore, Abdelhadi et al. teaches a system and method through which a Web user may distinguish those hyperlinks in each received Web document which are of interest to the user (Abdelhadi et al.: Abstract). At the display station of the user, the user is enabled to choose to view only a portion of a particular hypertext document that is linked to a particular hyperlink in the Web page. The user is also permitted to choose the size of the portion of the linked document to be viewed. Then, preferably in the browser, the selected portion of the hypertext document is accessed, stored and displayed. The user may then review this preview portion of the document and decide whether he/she wishes to see the whole linked Web document.

As previously noted, the features of original claim 7 have been incorporated into independent claim 1. With regard to claim 7, the Office action states that paragraph [0022] of Abdelhadi et al. teaches the claimed feature that an instruction is embedded within a network file such that the instruction is transparent to an end-user. The Office action states that the "instruction" is the "embedded hyperlink" of paragraph [0022]. This correlation between the "instruction" of Applicants' claimed method and the "hyperlink" of Abdelhadi et al. is consistent through the rejection of claims 1-11.

Applicants recognize that the claimed invention describes an instruction which is "embedded" and that paragraph [0022] of the prior art reference states that the Web pages contain "embedded hyperlinks" to other Web pages. However, the "instruction" of claim 1 is fundamentally different than the "hyperlink" of Abdelhadi et al. In fact, the "instruction" of Abdelhadi et al. teaches directly away from Applicants' claimed invention. In the language that was incorporated from claim 7 into claim 1, the instruction is described as being embedded such that the instruction is transparent to the end-user at the requesting device. The hyperlinks described in Abdelhadi et al. must be apparent to an end-user at a requesting device, or the hyperlinks are useless. Thus, paragraph [0022] of Abdelhadi et al. does not establish a *prima facie* case of obviousness with regard to amended claim 1. Even if one were to modify Abdelhadi et al. in view of Shrader et al. as proposed in the Office action, the resulting method would not render claim 1 obvious under Section 103(a).

As the Federal Circuit has held, obviousness is tested by what combined teachings of the prior art references would suggest to those of ordinary skill in the art. In re Fine, 5 USPQ2d 1596 (Fed. Cir. 1988). Applicants assert that a person of ordinary skill in the art would not interpret hyperlinks embedded within a Web page for aiding a user in searching or browsing the Web as being an "instruction embedded within the network file such that the instruction is transparent to an end-user." To the extent that hyperlinks of a Web page received by an end-user during searching or browsing is an "instruction," Abdelhadi et al. teaches away from the claimed invention, since the embedded hyperlinks described in paragraph [0022] of

the prior art reference would be rendered useless if they were embedded so as to be transparent to the end-user. The fact that the prior art references lead away from a claimed invention is both relevant and persuasive as to the issue of nonobviousness. W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303 (Fed. Cir. 1983).

Amended claim 1 also states that the indicator is transmitted from the requesting device as an automated response to receiving the network file. Prior to incorporation of the "automated" feature into claim 1, it was asserted that Abdelhadi et al. teaches the step of transmitting the indicator, since the prior art reference describes transmitting hyperlinks or URLs from a requesting device in response to receiving a network file. Specifically, the Office action cites claim 1 of Abdelhadi et al. Applicants respectfully assert that the amendment to the claim clearly distinguishes the transmitting step of Applicants' pending claim 1 from the teachings of Abdelhadi et al. The embedded hyperlinks of Abdelhadi et al. are not transmitted from a requesting device as an automated response to receiving the network file. Rather, during the searching or browsing through the Web as described in Abdelhadi et al., hyperlinks are presented to the user for selection. The Web page containing the hyperlinks enables selection, but the transmission of an indicator is not an automated response to receiving the Web page. A hyperlink/URL is transmitted only upon selection by a user.

While it is clear from the rejection of original claim 7 that the "instruction" as interpreted in the Office action is the "hyperlink," there is some reference in the Office action that the instruction is the "preview" as taught by Abdelhadi et al. Applicants point out that the preview of the prior art reference is not an instruction embedded within a network file that is received at a requesting device. Even more clearly, the preview is not embedded such that the preview is transparent to the end-user at the requesting device. Modifying Abdelhadi et al. such that the preview is transparent to the end-user at the requesting device renders the Abdelhadi et al. system and method unworkable for its intended purpose. As described in paragraph [0006] of Abdelhadi et al., a receiving display station of a user enables the user to choose to view only a portion of the hypertext document linked to a hyperlink. The user is

also permitted to select the size of the preview portion. The selected portion is then displayed to the user, rather than being transparent to the user. As described in paragraph [0026], the browser of the user of the Abdelhadi et al. invention is provided with the capability of enabling the preview when the browser is connected to a Web access server that has the capability of accessing and transmitting portions of documents.

Even if one were to use the aid of hindsight to modify Abdelhadi et al. in view of the teachings of Shrader et al., the resulting method would not render amended claim 1 obvious under Section 103(a). Shrader et al. teaches a scripting test architecture for Web server-based authentification. In rejecting claims 1-11, only lines 4-52 in column 3 of Shrader et al. were cited. These lines state that a tag within the source code of a test page may cause a JavaScript-enabled Web browser to dynamically evaluate its contents. Each five seconds, the browser window calls the reload test function, which calls the JavaScript reload method and the browser is caused to refetch the frame from the Web server. The current time and the URL of the Web page are displayed on the screen of the end-user every time the file is loaded. The patent states that as an alternative, the URL and time may be logged on an access tracking file.

Shrader et al. does not teach that the method of Abdelhadi et al. would benefit from a modification which would cause the Web document of Abdelhadi et al. to periodically reload. The JavaScript of Shrader et al. merely causes the browser to periodically reload. There would be no advantage in modifying Abdelhadi et al. to include this feature. Moreover, even if one were to modify Abdelhadi et al. to periodically reload, the resulting method would not render claim 1 obvious under Section 103(a). The reloading merely transmits a request for the same network file. The transmission of an indicator from the requesting device is not an automated response to receiving the network file.

In view of the incorporation of claim 7 into claim 1 and in view of the amendment to claim 1 to more particularly state that the transmission of the indicator is an automated response to receiving a network file, Applicants respectfully submit that claims 1-6 and 8-11 are allowable over the prior art.

C. Patentability of Claims 12-20

Claims 12-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Abdelhadi et al. in view of Shrader et al. and further in view of Duke et al. Both clarification and reconsideration are requested.

Duke et al. was cited for allegedly teaching a hit-tracking process. In meeting the requirement of providing a reason why a person of ordinary skill in the art would find it obvious to modify a primary reference in view of a secondary reference, the Office action states that incorporating an updating tally as taught by Duke et al. into Weinberg's apparatus would be obvious because "doing so would prevent exposure to loss of orientation while maintaining high data integrity" (page 6 of the Office action). Since the Weinberg reference has been removed as a basis for rejecting Applicants' claimed invention, it is assumed that the reference is to the "Abdelhadi et al./Shrader et al. apparatus." However, Applicants request explanation as to the motivation for modifying the Abdelhadi et al./Shrader et al. apparatus. It is Applicants' position that "preventing exposures to loss of orientation" is irrelevant to the Abdelhadi et al./Shrader et al. apparatus, so that a *prima facie* case of obviousness has not been established.

The reference to operating in a manner "for preventing exposures to loss of orientation while maintaining high data integrity" is found in lines 49-51 of column 3 in Duke et al. The Duke et al. patent relates to direct access storage devices (DASD). As described in the patent, DASDs provide large quantities of random access nonvolatile storage for data processing. Management of a storage hierarchy includes dynamically entering data into and deleting data from cache with the intent of increasing the proportion of the number of accesses that can be satisfied through the cache. Some commands involving writing cause the device to obtain "synchronization with the disk rotation (called orientation)" (Duke et al.: column 2, lines 60-67). While Duke et al. relates to concerns with exposures to loss of orientation, the loss of orientation is of no concern to either the system of Abdelhadi et al. or the system of Shrader et al. It would not be obvious to modify either of the two patents in view of Duke et al.

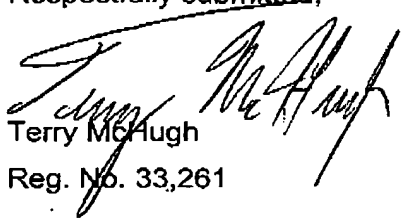
Moreover, Applicants assert that none of the three references teaches or suggests embedding executable code in each of a plurality of cacheable documents, wherein the executable code includes an instruction triggering transmissions of count-inducing messages (claim 12). The Office action cites paragraph [0022] in Abdelhadi et al. for teaching that a Web page includes an embedded hyperlink. However, the hyperlink as taught by the prior art reference merely causes transmission of a request for a document. That is, the hyperlink does not trigger a transmission of a count-inducing message. Additionally, the request for a Web page as taught by Abdelhadi et al. does not teach or suggest Applicants' step of receiving a count-inducing message transmitted from a client device as a response to execution of the executable code upon reception of the cacheable document. This is equally true of the cited portion of Shrader et al. (column 3, lines 44-52), since requests are for Web pages as a consequence of reloading at the user's browser.

Regarding independent claim 17, the hyperlinks embedded within a Web page as taught by Abdelhadi et al. do not teach or suggest a store of network files, "each of said network files having a command to initiate a transmission of an identifier from any one of a plurality of client devices upon receipt of one of said network files by said client devices." Abdelhadi et al. teaches the well known conventional techniques of requesting a file when a user selects the displayed hyperlink. This transmission of a file request as a consequence of selection by a user is fundamentally different than Applicants' claimed system, which includes programming configured to request network files and to transmit an identifier upon reception of the network file.

Applicants respectfully request reconsideration of the claims in view of the amendments and remarks made herein. A notice of allowance is earnestly solicited. In the case that any issues regarding this application can

be resolved expeditiously via a telephone conversation, Applicants invite the Examiner to call Terry McHugh at (650) 969-8458.

Respectfully submitted,



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